The Winzip helpfile document allows multiple files to be compressed and stored as a single archive file called a zip file. Those files can also be extracted and decompressed using an unzip operation. The step by step example the Examiner relies on in pages 6-8 describes creating two simple text document files one.txt and two.txt, saving them to a directory c:\foo, and creating a zip file c:\foo/test.zip to archive those files. Those two files then correspond in the rejection to the claimed "set of documents." Winzip allows viewing either of the files simply by double clicking on the filename or by performing an extract operation.

Without abandoning the arguments made in the last response, this paper focuses on just a few distinctions. There is no teaching of either one of the two document files one.txt and two.txt stored in the zip file "containing links" to the other file. Where in the Winzip helpfile document is one of one.txt and two.txt files described as having "links" to the other text file? The Examiner states that "HTML documents include hyperlinks that point to other documents." This is speculation by the Examiner. There is no teaching in the Winzip helpfile document that either of the two document files one.txt and two.txt is an HTML document.

To contend that these files "could be" HTML documents or that such links "could be" inserted into the two documents is impermissible hindsight. Many different executable file formats are described in the Winzip helpfile document, but the Examiner has not identified where HTML documents are described. The standard for obviousness is not the feasibility of doing something. There must be some express motivation in the prior art that suggests the desirability of doing it. See *Winner Int'l Royalty Corp. v. Wang*, 202 F.3d 1340, 1349 (Fed. Cir. 2000).

Where does the Winzip helpfile document describe scanning either document for links? The Examiner again improperly assumes that the two document files are HTML documents and

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seems to liken the claimed scanning for document links to compressing a file. The Examiner is requested to explain how compressing a file, where the amount of data in the file is reduced regardless of whether the data is a link or not, is the same as scanning a file for links, particularly HTML links since the Examiner is contending that the WinZip files are HTML documents.

The Examiner's contentions regarding "transforming the links into a format which is recognizable by the document browser" are untenable. The Examiner apparently abandons the earlier contention that NOTEPAD is the claimed browser. But what is the Examiner now reading the claimed browser on? If one accepts the Examiner's contention that a ZIP file is a single file database, then the "electronic document browser" requesting a compressed file in the ZIP file is the WinZip main window. But there is nothing in the Winzip helpfile document that describes the WinZip main window as understanding HTML or links within an HTML document as the Examiner's reading of the claim in the final rejection and response to arguments contends.

Indeed, as the Examiner appreciates, double-clicking on a file in the WinZip main window causes another application outside of the WinZip main window browser to open the file, like a web browser. But the claims do not recite two browsers—rather the browser that requested the document from the single database is the same browser for which the link format must be transformed. The Examiner's rejection improperly requires two different browsers: the WinZip main window browser and an HTML browser. Moreover, there is no teaching of any HTML browser in the Winzip helpfile document.

A broadest reasonable claim interpretation must be consistent to be reasonable. Requiring two different browsers to perform claim functions performed by one and the same browser in the claim is inconsistent. Speculations about HTML documents and HTML browsers that are not supported by any evidence in the prior art reference are likewise unreasonable.

"Broad" claim interpretation does not remove the Examiner's burden to provide evidence of claim features in the applied prior art reference.

In addition, the Federal Circuit *requires* consideration of the problem confronted by the inventor in determining whether it would have been obvious to combine references in order to solve that problem. *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 935 (Fed. Cir. 1990). Indeed, the Examiner must show reasons why one of ordinary skill in the art, confronted with the same problem as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. See *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998).
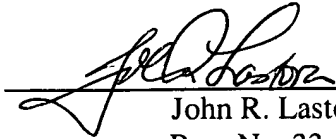
There is certainly no recognition in the Winzip helpfile document of the problems of using such a single file database when documents are retrieved by web browsers. Absent that recognition, it is clear that the Examiner's attempted combination lacks the requisite motivation. This is yet another deficiency in the final rejection. The *Rouffet* Court warned against "rejecting patents solely by finding prior art corollaries for the claimed elements" because that would "permit an Examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art." *In re Rouffet*, 149 F.3d at 1357. That approach was found by the Federal Circuit to be "an illogical and inappropriate process by which to determine patentability." *Sensonics v. Aerosonic Corp.*, 85 F.3d 1566, 1570 (Fed. Cir. 1996).

The application is now in condition for allowance. An early notice to that effect is earnestly solicited.

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Respectfully submitted,

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